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Paper No. 12
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Holland Company Inc. of the Carolinas

Serial No. 75/568,851

David E. Bennett of Coats & Bennett for The Holland Company Inc. of the Carolinas.

Brian J. Pino, Trademark Examining Attorney, Law Office 114 (Meryl Hershkowitz, Managing Attorney).

Before Hanak, Walters and Rogers, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

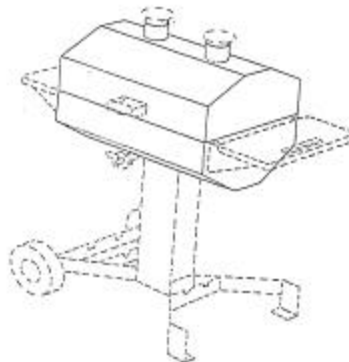
The Holland Company Inc. of the Carolinas has filed a trademark application to register the mark shown below on the Principal Register for "outdoor cooking grills."¹

Applicant submitted the following description of its mark:

The mark consists of the overall visual impression of the distinctive configuration of applicant's outdoor grill design featuring an octagonal housing with dual chimneys thereon. That part of the grill illustrated in dotted

¹ Serial No. 75/568,851, in International Class 11, filed January 13, 1998, based on an allegation of use of the mark in commerce, alleging first use as of June 30, 1988 and first use in commerce as of September 30, 1988.

outline is merely intended to show exemplary features of the grill in addition to the subject mark.



The Trademark Examining Attorney has issued a final refusal to register under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the grounds that the subject matter of the application is not inherently distinctive,² and that applicant has not established that the subject matter has acquired distinctiveness as a trademark.

² Although citing the proper statutory basis, the Examining Attorney refused registration on the ground that the subject matter is *de facto* functional and not inherently distinctive. *De facto* functionality is not a ground for refusal under the statute. In the case of a product configuration that is *de facto* functional, the proper ground for refusal on the Principal Register is that the configuration is not inherently distinctive as a matter of law, and thus does not function as a trademark under Trademark Act Sections 1, 2 and 45, 15 U.S.C. Sections 1051, 1052 and 1127. *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1282 (TTAB 2000).

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs³ and an oral hearing was held.

Applicant originally filed its application with a claim of acquired distinctiveness based on more than five years of substantially exclusive and continuous use. In the first office action, the Examining Attorney stated that the statement of five years use is insufficient in this case to establish acquired distinctiveness. Applicant responded by withdrawing its claim of acquired distinctiveness, asserting that the subject matter is inherently distinctive trade dress, and asserting, in the alternative, a claim of acquired distinctiveness based on evidence submitted therewith.

The Examining Attorney issued a final refusal on the ground that the subject matter is not inherently distinctive and the evidence submitted is insufficient to

³ With its brief, applicant submitted copies of evidence previously submitted and, for the first time, a copy of a prior registration owned by applicant. In his brief and at the hearing, the Examining Attorney objected to consideration of this additional evidence. Because it is untimely, we have not considered the copy of the registration submitted with the brief. We note that if we had considered the registration, our decision would not change. Applicant's prior registration would be of little probative value because we would not have the record in that case before us, nor would we be bound by the decision of the Examining Attorney in that case.

establish acquired distinctiveness. In the final refusal, the Examining Attorney stated as follows⁴:

The evidence of acquired distinctiveness is insufficient because none of the evidence shows that the configuration, that is the octagonal body of the grill with the smokestacks, but without the integral smokestack 'caps,' acts as a source indicator of the goods. There is no evidence in the record that shows the applicant has promoted the body of the grill with the smokestacks without the caps as a source indicator of the goods. (*emphasis in original*)

In its brief, applicant acknowledged the Supreme Court's decision in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529, U.S. 205, 54 U.S.P.Q.2d 1065 (2000), which found that product configurations can not be inherently distinctive trademarks, and withdrew its assertion that the product design comprising the subject matter of this application is inherently distinctive. However, applicant continues to contest the Examining Attorney's refusal based on the ground that applicant has not established that the subject matter has acquired distinctiveness as a trademark. Thus, our decision addresses only the issue of acquired distinctiveness.

⁴ While the Examining Attorney's argument includes the statement that the caps on the smokestacks are an integral part of the product design, this is a separate refusal relating to whether the subject matter of the application conforms to the mark as used on the specimens of record. That issue has not been properly raised in this appeal, nor was the issue raised during examination as a basis for refusal.

The burden of establishing acquired distinctiveness is on applicant. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1576, 6 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 1988), citing *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1405, 222 U.S.P.Q. 939, 942 (Fed. Cir. 1984); and *In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 160 USPQ 233 (CCPA 1969). To establish acquired distinctiveness, applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the producer. Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Sections 15:30, 15:61, 15:66 and 15:70 (4th ed. 1999).

In support of its claim of acquired distinctiveness, applicant submitted a claim of more than five years of substantially exclusive and continuous use; an affidavit by Barry Byars, a sales representative for an appliance

dealer; a declaration by Robert B. Holland, applicant's founder and president; excerpts from the May/June 1993 and March/April 1999 editions *Consumer Digest*; an excerpt from an undated publication entitled *Butane Propane News*; advertisements for applicant's product; a picture of applicant's logo; and a copy of a survey report submitted in another proceeding.

The Examining Attorney contends that applicant's consumer survey, conducted for prior litigation not involving this application, confirms the lack of acquired distinctiveness of the grill design; that applicant's own advertising does not point to or otherwise highlight the grill design as a source indicator; and that applicant's founder's opinion that its grill design is unique is inapposite.

The Examining Attorney submitted excerpts from Internet web pages advertising various third-party grills and cookers. He contends that this evidence establishes that there are other grills on the market with similar shapes. Applicant contends, however, that the pictures submitted by the Examining Attorney to show similar product designs are "pig cookers" rather than grills; and that pig cookers are sold through different channels of trade to a different class of purchasers. Applicant contends,

further, that similarly designed third-party grills are copies of applicant's "unique" product design.

After careful review of the evidence of record, we agree with the Examining Attorney that applicant's evidence of acquired distinctiveness is insufficient to permit registration of the product configuration under Section 2(f). While there is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, the burden is heavier in this case because it involves a product configuration. See *EFS Mktg., Inc. v. Russ Berrie & Co.*, 76 F.3d 487, 491, 37 U.S.P.Q.2d 1646, 1649 (2d Cir. 1996) ("[C]onsumers do not associate the design of a product with a particular manufacturer as readily as they do a trademark or product packaging trade dress."); *Duraco Prods. Inc. v. Joy Plastic Enter., Ltd.*, 40 F.3d 1431, 1452, 32 U.S.P.Q.2d 1724, 1742 (3d Cir. 1994) ("[S]econdary meaning in a product configuration case will generally not be easy to establish."); *Yamaha*, 840 F.2d at 1581, 6 U.S.P.Q.2d at 1008 (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue); *In re Sandberg & Sikorski Diamond Corp.*, 42 U.S.P.Q.2d 1544, 1548 (T.T.A.B. 1996) ("In view of the ordinary nature of these designs and the common use of gems in descending order of size on

rings, applicant has a heavy burden to establish that its configuration designs have acquired distinctiveness and would not be regarded merely as an ordinary arrangement of gems.").

With respect to applicant's sales and advertising efforts and expenditures, we concur with the Examining Attorney that applicant's showing is insufficient to establish acquired distinctiveness. While applicant claims to have total advertising expenditures as of May, 1997, of \$3,000,000, there is no indication as to the nature of that advertising or the nature and extent of the audience for that advertising. Further, these figures do not indicate whether the product configuration is featured in all of the advertising or whether the configuration is touted or otherwise emphasized as a trademark. While the grill is featured in the advertising submitted, and the functional features of the grill are identified, the grill configuration is not presented in a trademark manner.⁵

The *Consumer Digest* excerpts describe applicant's grill as "a truly unique grill" and "unique in style and performance." However, within the context of the articles

⁵ The submitted picture of applicant's logo showing the outline of the grill is not probative of the trademark significance of the three-dimensional grill as claimed, i.e., a grill with an octagonal housing.

these phrases appear to refer primarily to the functional features and performance of the grill.

Similarly, merely because applicant's president and applicant's sales representative consider the product design unique and applicant has used the product design since 1988 does not establish that it is perceived as a trademark by consumers.

We also find that the survey submitted is not particularly probative of the issue before us. The purpose of the survey, in another litigation, was to demonstrate that there was a likelihood of confusion between applicant's product design and another grill manufacturer's product design. The finding that respondents may have confused the two grill designs does not establish that applicant's grill design claimed in this application has acquired distinctiveness as a trademark. There are numerous reasons that could cause respondents' confusion.

In conclusion, there is very little evidence from which we can conclude that prospective and existing gas grill purchasers view the shape of applicant's grill as an indication of the source of that grill. Thus, we find that applicant has not established that the product configuration that is the subject of this application has acquired distinctiveness.

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Decision: The refusal to register under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the grounds that the subject matter of the application is not inherently distinctive, and that applicant has not established that the subject matter has acquired distinctiveness as a trademark, is affirmed.